

REMARKS**Summary of the Office Action**

Claims 1-4 and 7-12 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claims 1-4 and 7-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 4,573,625 to Olesen et al. ("Olesen") in view of U.S. Patent No. 6,923,360 to Sesek et al. ("Sesek").

Summary of the Response to the Office Action

Claims 1-4 and 7-12 are presently pending for further consideration. Claims 1, 7-8, and 12 have been amended. Claim 9 has been cancelled. Accordingly, claims 1-4, 7-8, and 10-12 are pending.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-4 and 7-12 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Specifically, the Examiner indicates that claims 1, 7-8, and 12 are indefinite in that it is unclear how the forming plate is capable of forming the staple member which is arranged "above" the movable anvil. Claims 1, 7, 8, and 12 have been amended to overcome the objection.

Finality of Office Action

Applicants respectfully traverse the finality of the Office Action. MPEP § 706.07(a) explains that “second or subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims, nor based on information submitted in an information disclosure statement... .” Despite this being the fourth Office Action, a new ground of rejection under 35 U.S.C. § 112, second paragraph has been introduced based on language in the claims that is unchanged from that of the original filing.

MPEP § 706.07 states that:

Before final rejection is in order a clear issue should be developed between the examiner and applicant.

[P]resent practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.

Clearly, waiting until the fourth Office Action to present a rejection which could have been included in the first Office Action cannot be considered to be cooperation by the Examiner as the MPEP explains that Applicants are owed. Applicants respectfully request the prompt withdrawal of the finality of the Office Action. Please contact Applicants’ representative should you not agree with withdrawal of finality.

Rejection Under 35 U.S.C. § 103(a)

Claims 1-4 and 7-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Olesen in view of Sesek. Applicants respectfully traverse the rejection of the claims.

There is nothing in Olesen that can be considered a fixed anvil as recited in claim 1.

Applicants will continue to recite the arguments of the previous two responses to Office Actions until they are properly addressed in an Office Action.

It is clear from Fig. 9 that only block 60 (alleged in the Office Action to be the moveable anvil of claim 1) is in the path of driver blade 80 and/or former 70 such that it can be considered an anvil. However, block 60 cannot be both a moveable anvil and a fixed anvil. Similarly, Fig. 19 only shows block 60' in the path of driver blade 80' and/or former 70' such that it can be considered an anvil.

Cartridge extensions 508 appear in the section view of Fig. 19 to be in the path of driver blade 80' and/or former 70', but Fig. 17 clearly shows cartridge extensions 508 to be above and outside of the width of the staple blanks. Thus, cartridge extensions 508 cannot be considered an anvil – fixed or moveable. Thus, Olesen does not disclose or suggest the fixed anvil recited in claim 1.

Sesek also does not disclose a fixed anvil as recited in claim 1. Element 110 of Sesek may be considered analogous to an anvil for forming staples from staple blanks. However, as described, e.g., at col. 5, lines 27-58 of Sesek, the forming anvil first member 112 and second member 132 move toward or away from one another. This is the gist of the invention, moving the anvil members to adjust the length of the legs of the staples. Thus, there is nothing in Sesek that can be considered the fixed anvil recited in claim 1.

Applicants respectfully assert that – absent a fixed anvil as recited in claim 1 – Olesen cannot be modified so that the forming plate is “capable of forming the staple member which is arranged above the movable anvil advanced into the striking path and the staple member which is successive to the staple member above the movable anvil simultaneously in the C-shape” as also recited in claim 1. If Olesen were modified to make the former wide enough to form two staples at once and there were no fixed anvil, there would be nothing to keep the second staple blank from breaking off as the former came down. If the groove 64 in the former block 60 of Olesen were made deeper to accommodate two staples, the driver blade 80 could either be wide enough to accommodate two staples – in which case it would drive two staples at once into the stacks of paper – or the driver blade could remain at the present width so that one staple would remain permanently in groove 64. In either case, the stapler would not operate properly.

Similarly, Applicants will respectfully reassert the arguments of the response dated May 2, 2008 until those arguments are properly addressed by the Examiner.

The Office Action of February 11, 2008 states that “claim 1 merely discloses a ‘fixed anvil’ and it is examiner’s position that Olesen’ (*sic*) extensions 508 read on the claimed fixed anvil, i.e. a structure formed at a front end of the staple guide for guiding the connected staples to the striking portion as described in applicant (*sic*) specification.” The Office Action totally ignores the fact that the fixed anvil recited in claim 1 is first and foremost an anvil.

The Applicant rather than the Examiner is the one given the freedom to be his or her own lexicographer. The Office Action cannot simply decree that an element in the prior art is the feature recited in the claims, ignoring the plain meaning of the words of the claim. Per MPEP § 2111.01, “the words of the claim must be given their plain meaning unless... the plain meaning is inconsistent with... the specification.” An anvil is “a heavy block... on which metals are shaped by hammering.” (THE AMERICAN HERITAGE COLLEGE DICTIONARY, 3d ed. (2000).) This is exactly how the term “anvil” is used in the specification of the present invention. This meaning is reinforced by claim 8, which states that “the staple member is formed in the C-shape on the fixed anvil.” Extensions 508 of Olesen are clearly not an anvil as recited in claim 1 (and especially claim 8) because no metal is shaped on extensions 508. Further, it is impossible for the extensions 508 of Olesen to be used as an anvil for forming a staple member into the C-shape as recited in claim 8.

The Office Action states that “the extensions 508 and lids (*sic*) 509 hold the staple member into the striking path while the guide’s front edge portion support said lead staple against it while deformation occurs” and suggest that this meets the requirement of being an anvil. In fact, Olesen states that elements 508 and 509 actually perform the opposite function from an anvil: “It is thus seen that the extensions 508, lips 509 and openings 100’ are shaped to cooperate among themselves to... prevent a staple wire from being bent, deflected, or removed...” (col. 11, lines 44-47; emphasis added.) To maintain that elements 508 and/or 509 constitute an anvil is ludicrous in light of the specification’s explanation of their function to prevent deformation of staples.

For at least the foregoing reasons, Applicants respectfully assert that claims 1-4, 7-8, and 10-12 are in condition for allowance.

Prompt allowance of claims 1-4, 7-8, and 10-12 is requested.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

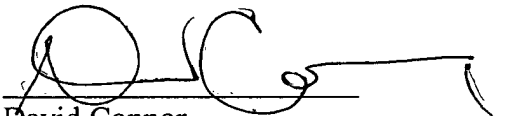
If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Dated: December 22, 2008

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